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OFFICE OF PETITIONS

In re Application of :
DeNatale, Mihailovich, Hacker, : DECISION DISMISSING PETITION
Rebeiz, and Tan : UNDER 37 CFR 1.47(a)
Application No. 10/676,875 :
Filed: 30 September, 2003 :
Atty Docket No. 00SC137US8 :

This is in response to the "RESPONSE TO DECISION REFUSING STATUS UNDER 37 CFR §1.47(a) IN LIEU OF REQUEST FOR RECONSIDERATION OF PETITION" which is treated as a renewed petition under 37 CFR 1.47(a) filed on 14 July, 2006.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION. Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 30 September, 2003, with a declaration naming Jeffrey F. DeNatale, Robert E. Mihailovich, Jonathan B. Hacker, Gabriel M. Rebeiz, and Guan-Leng Tan as joint inventors. The declaration was executed by all of the inventors except Rebeiz and Tan. On 19 February, 2004, a petition under 37 CFR 1.47(a) was filed with regards to the non-signing inventors. The petition was dismissed on 24 May, 2006.

The present request for reconsideration was filed on 14 July, 2006. Petitioners assert that the signatures of Rebeiz and Tan are not necessary on the declaration because petitioners are requesting, in an amendment under 37 CFR 1.312, that Rebeiz and Tan be deleted as inventors under 37 CFR 1.48(b).

It is noted that a grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

- (3) the petition fee;

- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

- (5) a statement of the last known address of the non-signing inventor.

Petitioners have not addressed the deficiencies outlined in the decision mailed on 24 May, 2006.

The petition is dismissed because petitioners have failed to state a cause of action. Specifically, 37 CFR 1.312 states that no amendment may be made as a matter of right in an application after the mailing of the notice of allowance. As such, petitioners' request under 37 CFR 1.48(b) is predicated upon the entry of the Rule 1.312 amendment.

Furthermore, such a change of inventorship may not be made as a matter of right because it is governed by 37 CFR 1.48(b) under which an amendment must be filed requesting the change.

The application will be referred for review of the amendment under 37 CFR 1.312. If the amendment is not entered, petitioner may wish to consider filing a petition under 37 CFR 1.183 to waive 1.48(a) in the event that the Rebeiz and Tan refuse or cannot be located to sign the appropriate documents.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The application will be forwarded to the Technology Center for consideration of the amendment under 37 CFR 1.312 filed on 14 July, 2006.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



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Office of Petitions